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Alex L. Yip Kaye Scholer LLP 425 Park Avenue New York, NY 10022				
			EXAMINER	
			PATEL, HEMANT SHANTILAL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,713	Applicant(s) COX ET AL.	
	Examiner Hemant Patel	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-81 and 83 is/are rejected.
- 7) ☒ Claim(s) 82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicant response dated June 11, 2007 to an Office Action dated February 8, 2007 is entered. Claims 57-83 are pending in this application.

Response to Arguments

2. Applicant's arguments filed June 11, 2007 have been fully considered but they are not persuasive.

3. **Regarding claim 57**, the Applicant argues (Remarks, pg. 9, last line) that Dowden does not teach or suggest the limitation of "a selected service to the caller.". The Examiner respectfully disagrees. Dowden clearly teaches that not only the system automated operator offers a selected service (as selected by the system to offer) to setup a call to VMS when the system encounters non-answering condition (called party busy, timed no answer) (Dowden, Fig. 3, step 1516 and corresponding descriptions in the reference art), but also the caller selects the offered service by pressing key 9 or *867 (Dowden, Fig. 3, response connection from step 1516 to step 1518 and corresponding descriptions in the reference art) to connect to the VMS to leave a message for the called party. Then the system automated operator provides (offers) the selected (as selected by the system as well as selected by the caller) service by connecting the caller to the VMS to leave a message (Dowden, Fig. 4, steps 1524, 1530, 1535, 1536, 1538, 1540 and corresponding descriptions in the reference art).

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4. **Regarding claim 70**, the Applicant argues (Remarks, pg. 11, ll. 2-4) that Dowden does not teach or suggest the limitation of "while continuing the attempt to establish the telephonic connection,". The Examiner respectfully disagrees. Dowden clearly teaches that the system automated position monitors the call and offers selected service of connecting to VMS (Dowden, Fig. 3, step 1516 and corresponding descriptions in the reference art) while at the same time waiting for answer from the called party (i.e. while continuing the attempt to establish the telephonic connection, Dowden, Fig. 3, step 1516 with exit condition of ANSWER leading to step 1514 to complete call conventionally, refer to corresponding descriptions in the reference art) and waiting for the caller to select a the offered service by pressing key 9 or *867 on the telephone keypad (Dowden, Fig. 3, response connection from step 1516 to step 1518 and corresponding descriptions in the reference art) for the system to connect the caller to the VMS for the caller to leave a message for the called party (Dowden, Fig. 4, steps 1524, 1530, 1535, 1536, 1538, 1540 and corresponding descriptions in the reference art).

Response to Amendment

5. Applicant's arguments with respect to claims 57-83 have been considered but are moot. The new rejections are necessitated due to addition of new claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 57-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,456,709 (hereinafter referred to as Parent '709). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than ones in patent Parent '709. *In re Van Ornum and Stang*, 214 USPQT61, broad claims in continuation application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 57 of instant application recites limitations similar to those in claim 1 of Parent '709, except the claim 57 of instant application does not recite specific limitations of eliciting directory assistance request, searching a database for a destination telephone number that satisfies the directory assistance request, allocating and monitoring the outbound channel using a signal processing device. It also does not recite non-answering condition as specifically a

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network communication problem as specified in claim 1 of Parent '709. Thus, the claim 57 of instant application is broader than claim 1 in the Parent '709 patent.

8. Claims 70-81 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,456,709 (hereinafter referred to as Parent '709). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than ones in patent Parent '709. In re Van Ornum and Stang, 214 USPQT61, broad claims in continuation application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 70 of instant application recites limitations similar to those in claim 16 of Parent '709, except the claim 70 of instant application does not recite specific limitations of eliciting directory assistance request, searching a database for a destination telephone number that satisfies the directory assistance request, allocating and monitoring the outbound channel using a signal processing device. Thus, the claim 70 of instant application is broader than claim 16 in the Parent '709 patent.

9. Claim 83 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,456,709 (hereinafter referred to as Parent '709) in view of Dowden (US Patent No. 5,181,237). The claim 83 of instant application recites limitations similar to those in claim 13 of Parent '709, except the claim 83 of instant application does not recite specific limitations of eliciting directory assistance request, searching a database for a destination telephone number that satisfies the directory assistance request, allocating and monitoring the outbound

channel using a signal processing device. It also does not recite non-answering condition as specifically a network communication problem as specified in claim 13 of Parent '709.

The claim 13 of Parent '709 does not recite the instant application claim 83 limitations of selecting the option of recording a message by pressing a predetermined key on the communication device, recording the message when the predetermined key on the communication device is pressed and then delivering the message to the destination party.

However, in the same field of endeavor, Dowden teaches of detecting non-answering condition (busy or timed no answer) and offering a selected option of connecting to voice mail service (VMS) wherein the caller selects this option by pressing key 9 on the calling device as a result of which the system records caller's message for the destination party (Figs. 3, 4 and their corresponding descriptions in the reference art) and delivers the recorded message to the destination party (Fig. 5 and its corresponding descriptions in the reference art).

It would have been obvious to a person of ordinary skill in the art to modify Parent 709 to offer the option of recording a message to the caller which the caller selects by pressing specific key on the calling device and a result the system records caller's message and delivers the message to the destination party as taught by Dowden in order "to offer spontaneous voice messaging service in case the call cannot be completed because the called party is busy or does not answer" (Dowden, col. 8, ll. 28-31).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 82-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 82 and 83 recite "the caller" (ll. 5, 9, 12). It is not clear if it refers to "a caller" recited on line 1 or recited on line 2.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 57-61, 63, 68, 70-75, 80, 83 are rejected under 35 U.S.C. 102(b) as being anticipated by Dowden (US Patent No. 5,181,237).

Regarding claims 57, 60, Dowden teaches of a method for providing directory assistance services to a caller comprising:

receiving a call from the caller, the call including a directory assistance request (col. 5, ll. 67-col. 6, ll. 41; dialing a call for assistance related to directory number i.e. calling collect, person-to-person, operator, or third number call etc.; also Fig. 3, steps 1550, 1552, 1554 and corresponding descriptions in the reference art);

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in response to the directory assistance request, attempting to establish a telephonic connection between the caller and a destination party (col. 6, ll. 42-43);

detecting a connection status signal concerning an establishment of the telephonic connection (col. 8, ll. 48-49; detecting called terminal busy signal);

before automatically transferring the caller to a directory assistance provider, determining whether the connection status signal indicates a non-answering condition (col. 8, ll. 48-49; detecting busy signal); and

automatically transferring the caller to a directory assistance provider, and offering a selected service to the caller when it is determined that the connection status signal indicates a non-answering condition (col. 8, ll. 48-52; automated position offering to set up a VMS call on busy or no-answer condition; refer to further explanation regarding claim 57 in the Response to Arguments section).

Regarding claim 58, Dowden further teaches that the directory assistance provider comprises voice server (col. 5, ll. 60-col. 9, ll. 61; providing voice services).

Regarding claim 59, Dowden further teaches that the directory assistance provider comprises a live operator (Fig. 1, item 24).

Regarding claim 61, Dowden further teaches that the non-answering condition includes a ring-no-answer condition (col. 8, ll. 48-49; timed no-answer).

Regarding claim 63, Dowden further teaches that the selected service includes recording a message to be delivered to the destination party (col. 8, ll. 32-col. 9, ll. 68; col. 10, ll. 37-col. 11, ll. 13; voice message).

Regarding claim 68, Dowden further teaches of ISDN D channel and LAN for out-of-band signaling (col. 7, ll. 31-col. 8, ll. 22).

Regarding claims 70, 74, Dowden teaches of a method for providing directory assistance services to a caller comprising:

receiving a call from the caller, the call including a directory assistance request (col. 5, ll. 67-col. 6, ll. 41; dialing a call for assistance related to directory number i.e. calling collect, person-to-person, operator, or third number call etc.; also Fig. 3, steps 1550, 1552, 1554 and corresponding descriptions in the reference art);

in response to the directory assistance request, attempting to establish a telephonic connection between the caller and a destination party (col. 6, ll. 42-43);

detecting a connection status signal concerning an establishment of the telephonic connection (col. 8, ll. 48-49; detecting timed-no-answer);

before automatically transferring the caller to a directory assistance provider, determining whether the connection status signal indicates a ring-no-answer condition (col. 8, ll. 48-49; detecting timed-no-answer); and

automatically transferring the caller to a directory assistance provider while continuing the attempt to establish the telephonic connection when it is determined that the connection status signal indicates a ring-no-answer condition (col. 8, ll. 48-52; automated position offering to set up a VMS call on timed no answer; refer to further explanation regarding claim 70 in the Response to Arguments section).

Regarding claim 71, refer to rejections for claim 70 and claim 58.

Regarding claim 72, refer to rejections for claim 70 and claim 59.

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Regarding claim 73, Dowden teaches of providing announcement to the caller if the called party does not answer and is transferred to the operator position (col. 8, ll. 48-52).

Regarding claim 75, refer to rejections for claim 74 and claim 63.

Regarding claim 80, refer to rejections for claim 70 and claim 68.

Regarding claim 83, Dowden teaches of a method for providing directory assistance services to a caller comprising:

receiving a call from a caller using a communication device, the call including a directory assistance request (col. 5, ll. 67-col. 6, ll. 41; dialing a call for assistance related to directory number i.e. calling collect, person-to-person, operator, or third number call etc.; also Fig. 3, steps 1550, 1552, 1554 and their corresponding descriptions in the reference art);

in response to the directory assistance request, attempting to establish a telephonic connection between the caller and a destination party (col. 6, ll. 42-43);

detecting a connection status signal concerning an establishment of the telephonic connection (Fig. 3, entry conditions of Busy and/or Timed No Answer to step 1516 and corresponding descriptions in the reference art);

determining that the connection status signal indicates a non-answering condition; in response to the connection status signal, automatically presenting to the caller an option to record a message to be delivered to the destination party, the option being selected by pressing a predetermined key on the communication device (Fig. 3,

step 1516 with entry conditions of Busy and/or Timed No Answer and with exit condition of Keyed 9, or *867; and corresponding descriptions in the reference art);

recording a message provided by the caller, when the caller presses the predetermined key on the communication device (Fig. 3, step 1516 with exit condition of Keyed 9, or *867; Fig. 4, steps 1524, 1530, 1535, 1536, 1538, 1540 and corresponding descriptions in the reference art); and

delivering the message to the destination party (Fig. 5 and its corresponding descriptions in the reference art).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dowden as applied to claim 57 above, and further in view of knowledge well known in the art.

Regarding claim 62, Dowden does not specifically teach of network communication as non-answering condition.

However, it is very well known in the art that network communication failure causes the busy condition indicated by fast busy signal.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Dowden to include this network communication failure condition indicated by fast busy signal that causes no answer from the called party in order to provide the caller some alternative useful completion of the call in case of network congestion.

17. Claims 64-67, 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowden as applied to claims 57, 74 above, and further in view of Yablon (US Patent No. 5,764,731).

Regarding claim 64, 65, 66, Dowden does not specifically teach of providing destination party telephone number information through caller device.

However, in the same field of endeavor, Yablon teaches of directory assistance providing destination party telephone number in the form of DTMF tones that the caller device can store for later use (col. 6, ll. 5-47).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Dowden to provide telephone number of called party in

the form of DTMF tones to the caller as taught by Yablon so that "If the number is busy, or the called party is not available, it can be called back at a later time without going again through directory assistance, averting one of the problems of call completion" (Yablon, col. 8, ll. 13-17).

Regarding claim 67, Yablon further teaches of the use of pager telephone (col. 19, ll. 41-64).

Regarding claim 76, refer to rejections for claim 74 and claim 64.

Regarding claim 77, refer to rejections for claim 76 and claim 65.

Regarding claim 78, refer to rejections for claim 76 and claim 66.

Regarding claim 79, refer to rejections for claim 78 and claim 67.

18. Claims 69, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowden as applied to claims 68, 80 above, and further in view of Wattenbarger (US Patent No. 5,835,570).

Regarding claim 69, Dowden does not specifically teach of using common channel signaling system 7.

However, in the same field of endeavor, Wattenbarger teaches of using SS7 out-of-band signaling for directory assistance and call connection set up (col. 4, ll. 37-col. 5, ll. 20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Dowden to use SS7 out-of-band signaling for directory assistance and call set up as taught by Wattenbarger as the use of industry standard

SS7 out-of-band signaling avoids using the dedicated voice channels for the intermittent and bursty traffic of signaling and control messages as is well known in the art.

Regarding claim 81, refer to rejections for claim 80 and claim 69.

Allowable Subject Matter

19. Claim 82 is objected to due to its rejection under 35 USC 112 2nd paragraph rejection, but would be allowable if rewritten in proper form including all of the limitations.

Regarding claim 82, Dowden teaches of a method for providing directory assistance services to a caller comprising:

receiving a call from a caller using a communication device, the call including a directory assistance request (col. 5, ll. 67-col. 6, ll. 41; dialing a call for assistance related to directory number i.e. calling collect, person-to-person, operator, or third number call etc.; also Fig. 3, steps 1550, 1552, 1554 and corresponding descriptions in the reference art);

in response to the directory assistance request, attempting to establish a telephonic connection between the caller and a destination party (col. 6, ll. 42-43);

detecting a connection status signal concerning an establishment of the telephonic connection (Fig. 3, exit conditions of Busy and/or Timed No Answer to step 1510 and corresponding descriptions in the reference art);

determining that the connection status signal indicates a non-answering condition (Fig. 3, step 1516 with entry conditions of Busy and/or Timed No Answer and corresponding descriptions in the reference art).

Dowden teaches of automatically presenting to the caller an option to connect to voicemail service but does not teach of automatically presenting to the caller an option to receive a telephone number associated with the destination party by pressing a predetermined key on the communication device in response to the connection status signal, and providing to the caller the telephone number associated with the destination party when the caller presses the predetermined key on the communication device.

The other prior art of record Morganstein (US Patent No. 4,809,321) teaches of instructing the caller about the dialing of an alternate telephone number when the destination party is busy or does not answer.

The destination party phone number not known to the caller is commonly known as the unlisted, unpublished or private telephone number. The prior art of record does not teach of giving out such unlisted, unpublished or private phone number.

The prior art of record Dowden, Morganstein alone or in combination with other prior art record does not teach the specific feature of giving an option to the caller to receive destination party phone number if destination party is busy or does not answer, wherein the caller is given the destination party phone number when the caller presses predetermined key to receive the destination party phone number.

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating

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that amended claims broadly reciting certain limitation discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of Allowance if and when all claims in the application are put in a condition for allowance.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel
Examiner
Art Unit 2614

HSP

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FAN TSANG
SUPERVISORY PATENT EXAMINER
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